

Appln. No. 10/064,589  
Docket No. 124615 / GEM-0032

### REMARKS / ARGUMENTS

#### Status of Claims

Claims 1-3, 5-10 and 12-31 are pending in the application. Claims 1-3, 5-10 and 12-30 stand rejected. Claim 31 is objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's notation of allowable subject matter. Of the pending claims, Applicant has canceled Claim 28, and has amended Claims 1, 6, 12, 16, 21, 27 and 29-31, leaving Claims 1-3, 5-10, 12-27 and 29-31 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the final rejection. The claim amendments presented herein, which Applicant respectfully requests entry thereof, should only require a cursory review by the Examiner.

#### Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 5-10 and 12-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aoki et al. (U.S. Patent No. 6,275,128 B1, hereinafter Aoki) further in view of Rapoport (U.S. Patent No. 6,670,877 B2, hereinafter Rapoport).

Applicant traverses the Examiner's rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of

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establishing that all elements of the invention are taught or suggested in the prior art.  
MPEP §2143.03.

The Examiner comments that Claim 31 is directed to allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Paper 20040319, page 5).

Regarding Claims 28-30

Applicant has canceled Claim 28 and has rewritten allowable Claim 31 in independent form to include limitations from Claim 28 that reflect Applicant's invention. Claims 29-30 have been amended to depend from Claim 31.

In view of the foregoing amendments, Applicant submits that Claims 29-30 are directed to allowable subject matter, and therefore respectfully requests entry thereof.

Regarding Claims 1-3, 5-10 and 12-27

Applicant has amended independent Claims 1, 6, 12, 16, 21 and 27 to include limitations from allowable Claim 31, and to more clearly reflect Applicant's invention. More specifically, Claims 1, 6, 12, 16, 21 and 27 now recite, inter alia, "...wherein said plurality of shims includes a first shim having a first amount of material and a second shim having a second different amount of material", which Applicant submits is directed to patentable subject matter. Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim.

In view of the foregoing amendments, Applicant submits that Claims 1-3, 5-10 and 12-27 are directed to allowable subject matter, and therefore respectfully requests entry thereof.

Allowable Subject Matter

The Examiner comments that Claim 31 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has rewritten Claim 31 in independent form to include limitations from Claim 28 that reflect Applicant's invention.

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In view of the foregoing amendments, Applicant submits that Claim 31 is directed to allowable subject matter, and therefore respectfully requests entry thereof.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

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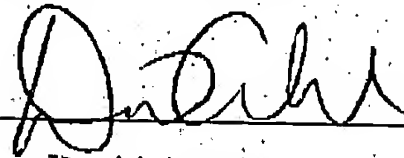
The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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